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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,359

Applicant(s)

FUJITA, ICHIRO

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 21 and 22 have been examined.

Response to Amendment

2. The Amendment filed on 5/31/05 is sufficient to overcome the Perkowski and Gardenswartz references. A new reference has been added to the 35 USC 103 rejection.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/31/05 has been entered.

Claim Objections

4. Claim 21 and 22 objected to because of the following informalities. Claim 21 states "to incoming of log-in" and "to select a processing and". These features are not written in appropriate language. The claim should read something like "to incoming log-in" and "to select a processing option and". Appropriate correction is required. Claim 22 states "to be processed with stored product information". The claim should read something like "to be processed which has stored product information".

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are rejected under 35 U.S.C. 101 because these claims have no connection to the technological arts. The method claims do not specify how the claims utilize any technological arts. For example, no network or server is specified. To overcome this rejection, the Examiner recommends that the Applicant amend the claim to specify or to better clarify that the method is utilizing a medium or apparatus, etc within the technological arts. Appropriate correction is required.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first

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test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

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In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in

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affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the current application, no technological art (i.e., computer, network, server) is being utilized by claims 22. At least one step of the body of the claims must explicitly utilize the technological arts. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gould (6,693,236), Perkowski (6,625,581) in view of Gardenswartz (6,055,573).

Claims 21 and 22:

Gould discloses providing to the user a list of user owned products or items:

“(11) The present invention provides a system method and apparatus for allowing a computer user to maintain an inventory of goods or services in an organization which is customized to the user's individual needs. The organized items include both those items owned by the user and those which need to be purchased, and the user is provided with an indication of which items fall into which category, allowing the user to easily determine which items remain to be purchased. Purchase can be made directly by selecting the needed item without requiring

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the user to compile a list of items and without visiting different vendors to purchase all needed items (col 2, lines 48-60);

(12) More particularly, the invention includes a user interface which displays a plurality of category icons each of which represents a user defined grouping of items. These items and groupings are organized in any manner designed by the user. Selecting one of the category icons causes the items within that group to be displayed with an associated status icon. The status icon associated with each item indicates to the user whether the item is currently owned by and available to the user, whether it needs to be purchased, or whether it has been purchased but has not yet been received (col 2, line 60-col 3, line 5);

(17) This dealer supplied list 504 could include all inventory in that category or a filtered subset thereof. From this list, the user can contract the list to show just those items which are already owned by the user, only those which are not owned or some user defined combination thereof. Therefore, upon receiving the filled list from the music dealer, the user can, upon a simple inspection of the status icons 504, determine whether he or she already owns each of the items suggested by the dealer. The user can then select an un-owned title 504, listen to a sample of the music, and, if desired, purchase the title 504" (col 6, lines 44-55).

Gould discloses providing Item information on items not yet owned and on items owned:

"(13) The item window can include information such as price, availability, size, graphics, etc. The purchase mechanism can be in the form of a button which the user can select to initiate an on-line purchase. The selection of vendors can be preprogrammed, determined in real time, or can be by default, however, the system automatically determines which stores supply the item and provides a link to only those stores (col 3, lines 7-15);

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(16) In yet another embodiment of the invention, the user interface allows a user to easily manage vehicle maintenance. Each vehicle owned by the user is provided with its own icon, selection of which will provide the user with information regarding the maintenance schedule of that vehicle. The system keeps track of maintenance already performed and alerts the user when maintenance is due. The system also provides the user with a selection of service stations from which such service can be provided and also provides the user with links to the service station to schedule such maintenance” (col 3, lines 40-54).

Gould discloses informing vendors of user information related to items and information related to item purchasing and needed items:

“(6) In a step 310, the software automatically searches for on-line vendors from among the agents 14 (FIG. 2) which can provided the item, preferably focussing on certain user preferred vendors 312. Then, in a step 314, the user purchases the item. In a step 316, the user checks the software to determine whether additional items remain to be purchased. If so then the user returns to step 308, if not then the user is done (col 4, lines 60-67);

(17) Similarly, with reference to FIG. 5, the user can send one of his embedded list titles 508 to a music dealer as an empty list with a request to fill the lists with titles matching those categories. The music dealer can then fill the user's embedded list 502 with a list 504 that matches the user's categorization. This dealer supplied list 504 could include all inventory in that category or a filtered subset thereof. From this list, the user can contract the list to show just those items which are already owned by the user, only those which are not owned or some user defined combination thereof. Therefore, upon receiving the filled list from the music dealer, the user can, upon a simple inspection of the status icons 504, determine whether he or

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she already owns each of the items suggested by the dealer. The user can then select an un-owned title 504, listen to a sample of the music, and, if desired, purchase the title 504” (col 6, lines 38-55).

Notice in Gould that the listing of user owned products is automatically provided for the particular user and that the users is not required to enter data on a product in order to obtain more information on that product. Also, notice in Gould that while Gould discloses providing additional product information (above) that Gould’s displaying of products owned by the user including the product name is displaying product information on products owned by the user (Fig. 6, Fig. 7; Fig. 8). Also, notice that Gould discloses providing further product information on products owned by a user (Fig. 8, item 816, ‘schedule’; Fig. 8, item 812, ‘Maintenance History’).

Also, notice throughout Gould that Gould’s user is uniquely identified because of the disclosure of listings of owned products/items for a particular user. Also, Gould discloses that he user can have a particular account:

“(24) It will be appreciated that the activity of purchasing each item can be done directly from the user interface each time an item is used up. The purchases can be tallied in an account (not shown) which can be checked at any time to determine the amount charged” (col 8, lines 5-10).

Additionally, Perkowski discloses building detailed profiles of buyers (col 33, lines 24-30); maintaining customer communication before and after purchase, including being able to provide product information to a customer (col 2, lines 27-45); and that manufacturers continue

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to communicate with buyers after purchase in order to increase the chance of future sales and that the communication includes providing product related information (col 104, lines 20-41).

Perkowski further discloses that both manufacturers, retailers, or advertisers maintain communications with consumer after purchase (col 5, lines 15-25).

Perkowski discloses providing various product related information:

“Such information resources can include advertisements, specifications, operation descriptions, product simulations, purchase information, maintenance information, warranty and servicing information, product updates, distributor/reseller information, incentives (e.g. discounts, rebates, coupons, etc.), electronic data transaction screens, etc.” (col 95, lines 28-36), and,

“CYBER-SERVICE.TM., accessible through a particular UPC REQUES.TM. Retail Website or the UPC REQUEST.TM. Central Website, enables consumers at home, in the office, on the road, and in retail stores, to quickly access particular types of product-related information which have been published on the WWW by registered manufacturers, their agents and others about consumer products registered with the UPC REQUES.TM. Database Management System. CYBER-SERVICET.TM. displays such product-related information in a menu-like format organized by particular information types (e.g., Product Advertisements, Product Endorsements, Product Reviews, Product Rebates and Incentives, Product Description, Product Manual/Instructions, Product Updates (at FTP Sites), Product Returns, Warranty and Repair Service, Direct Product Purchase, Retailers, Wholesalers, Complementary Products, Company Annual Report, Stock Purchase, etc.). Each displayed information menu associated with a consumer product contains hyper-linked URLs pointing to HTML-documents containing

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particular types of product-related information linked to the product by the manufacturer or its agent” (col 101, lines 10-32).

Also, the 'to select a processing and' of claim 21 is broad and can be interpreted in many ways. Also, the user in Perkowski selects a product (Fig 3a2; Fig. 1a1; Fig. 4m2) and also logs in (Fig. 4o1, item 'My Account'; Fig. 4T1, item 'Log On'). Perkowski discloses displaying a listing of products (Fig. 4a2). Perkowski discloses building profiles of users as buyers and displaying a list of products to a user that match a user profile (col 33, lines 25-30).

Additionally, Gardenswartz discloses a user information providing unit for providing user information to advertisers, retailers, stores, chain, wholesaler of the products owned by users based on the user attribute information and user-owned product information (Fig. 1; Fig. 2a; Fig. 2b; Fig. 5; col 5, line 60-col 6, line 5). Also, Gardenswartz discloses tracking all purchases made by a particular customer (col 15, lines 60-65; col 6, lines 19-25).

Gardenswartz discloses the user logging in and being uniquely identified:

“In this embodiment, the value contracts may be Internet banners which are automatically sent to the consumer's computer by a Web server upon recognizing the consumer's computer or upon the consumer's entry of a password, for example” (col 15, lined 45-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Perkowski's further product information and Perkowski's and Gardenswartz's further communications between the manufacturer/vendor and the targeted/user of interest and Perkowski's and Gardenswartz's further features with a user with a login/account to Gould's features for maintaining and providing a listing of user owned products, providing further product information, and informing a manufacturer/vendor of user information related to

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products. One would have been motivated to do this in order to better provide users with information on products of interest.

Hence, the combination of Gould, Perkowski, and Gardenswartz renders obvious the Applicant's claimed features of:

automatically extracting... user-owned product information of said user from said user information storage unit based on the log-in information of the user, displaying a list of user-owned products of said user... based on said automatically extracted user-owned product information..." (claim 21) and

providing the user with product information related to the user-owned product without requiring the user to enter data of the user-owned product and providing a manufacturer of the user-owned product with user information based on the linkage" (claim 22).

Response to Arguments

7. Applicant's arguments with respect to claims 21 and 22 have been considered but are moot in grounds of the new rejection.

Examiner notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art and that claims are given their broadest reasonable interpretation.

Examiner notes that while specific references were made to the prior art, that it is actually a 35 USC 103(a) rejection that is made and that it is the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

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Also, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Newman (5,665,951) discloses maintaining a listing of user owned products and communicating between a vendor/manufacture and a user;

Roberts (6,101,486) discloses maintaining a listing of user owned products:

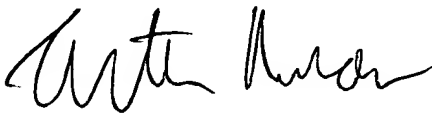
“(23) A comparison between the customer profile and the company database is performed to create a listing of products or services not currently owned or used by the customer (Step 440). Preferably, the customer profile includes a listing of services and products currently possessed by the customer. This first comparison generates a product list that includes products within the company's database that are not currently owned by the customer and of potential interest to the customer. Any information or advertisement for previously purchased products would be a duplication, and therefore of little use to the customer. Likewise, if a customer has already purchased a particular product from the company, the comparison would identify products and services that could operate in conjunction with, or offer improvements over, the customer's current inventory of products and services.”

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Arthur Duran', is positioned above the printed name.

Arthur Duran
Patent Examiner
7/5/05